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DANIEL S. POLLEY, P.A. 1215 EAST BROWARD BOULEVARD FORT LAUDERDALE, FL 33301			CHAMPAGNE, DONALD	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09825269

MAILED

Filing Date: 3 April 2001

DEC 13 2007

Appellant(s): Renee FRENGUT et al.

GROUP 3600

Daniel S. Polley, Esq., For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6 September 2007 appealing from the Office action mailed 8 February 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Gerace, US005848396A, 8 December 1998

Tuzhilin, US006236978B1, 22 May 2001.

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 8 February 2007.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 16 November 2006 and in the brief filed on 20 April 2006 have been fully considered but they are not persuasive. The arguments have been addressed by revision of the rejection to accommodate the amendment.
2. In particular, the examiner has given numerous examples where Gerace teaches the user personally and knowingly inputting information for knowingly creating their user profiles. That the reference also teaches passive means for contributing to the user profile does not obviate the fact that the reference reads on the claims. A reference is available as prior art for all that it teaches (MPEP § 2123.I).

Claim Rejections - 35 USC § 102 and 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1-3, 6-10, 12-23 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerace (US005848396A).

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6. Gerace teaches (independent claim 1) a method for generating a customized *Home Page* (col. 4 line 3), which reads on a customized interface, comprising the steps of:
 - associating in a computer one or more ads with respective ad profiles (col. 3 lines 4-10);
 - displaying an online page (*Home Page*, col. 4 lines 1-4) to one or more users seeking information (*user identification information*, col. 5 lines 5-7, and *user provides certain data*, col. 11 line 32) from the one or more users and allowing the one or more users to knowingly enter their information (*nickname, password, e-mail address, postal address, credit card number, and the like*, col. 6 lines 2-5 and col. 13 lines 62-63, and *zip code*, col. 16 lines 30-36) for creating their respective one or more user profiles (col. 5 line 63 to col. 6 line 1 and the personalized *Weather Page/Screen View*, col. 16 lines 30-36, and the customized content and screen formats, col. 11 lines 24-35);¹
 - associating in a computer the one or more user profiles with the respective one or more users, (col. 5 line 63 to col. 6 line 5), with each user profile created from user responses to agate information (col. 4 lines 12-23), which reads on created from information inputted by a corresponding user and transmitted to the computer, wherein each user personally and knowingly assists in the creation of his or her user profile by knowingly inputting the information (making *user selections*, col. 4 lines 7-11) and is aware that the information will be used to create a customized interface/*Home Page* (because said customized interface/ *Home Page* appears in response to the user's selections and expressed preferences, col. 4 lines 23-28),
 - determining matching ad profiles by comparing the ad profiles with user profiles for matches (col. 2 lines 31-34 and col. 35 lines 64-67), and
 - selectively including in the interface (page) of a user at least one of the one or more ads associated with the ad profiles matching a user profile associated with the user (col. 2 lines 24-29).

¹ In addition, Gerace teaches (col. 17 line 53 to col. 18 line 9) displaying an online page to one or more users (*sponsor-users*) seeking information from the one or more user/*sponsor-users* and allowing the one or more user/*sponsor-users* to knowingly enter their information for creating their respective one or more user profiles (the *advertisers template*).

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7. Gerace also teaches: (independent claims 6 and 30) storing statistical data determined according to the matches (col. 2 lines 35-42), selecting the ad(s) according to said statistical data and an anonymous user (col. 2 lines 43-53 and col. 32 lines 54-56); (independent claim 9) charging the advertiser in accordance with the matches (col. 12 lines 7-21); (independent claims 27 and 16) providing the page/interface to the user, in response to a user action (logging on to *program 31*, col. 4 lines 1-2 and 25-27); and (independent claim 12) formatting the page/interface in accordance with the user profile (col. 2 lines 16-23).
8. Gerace also teaches at the citations given above claims 2, 3, 17 and 29 (inherently, because no special meaning is disclosed for "consistent").
9. Gerace also teaches at the citations given above claims 7, 8, 10 (where "number of users having matching user profiles" reads on *number of times the ad is presented to and viewed by users*), 18-23 and 28 (where the ad profile parameters themselves read on "information about a targeted audience for the ad").
10. Gerace also teaches claim 15, because the *Page Display Object 35c* defines *page outlines* (col. 7 lines 39-40), which read on a page "framework", and the user adds said *outline/framework* to the user profile by selecting such a page for viewing (col. 7 lines 53-57). Accordingly, Gerace also teaches claims 13 and 14 because these outlines (Appendix I beginning in col. 23) fully define *page outlines including spaces*.
11. Claims 11 and 24-26 are rejected under 35 U.S.C. 103(a) as being obvious over Gerace.
12. Gerace does not teach (claims 11 and 24) charging the advertiser based on the amount of ad space available. Because both ad cost and demand from advertisers increases with ad size, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Gerace that advertisers are charged based on the amount of ad space available. Gerace does teach the added limitations of claim 25 (col. 2 lines 16-23).
13. Gerace does not teach (claim 26) charging the advertiser based on when the user receives the ad. Because the value to the advertiser depends on the timing of some ads (e.g., Christmas sale ads are valuable only before Christmas), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the

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teachings of Gerace that advertisers be charged based on when the user receives the ad.

14. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being obvious over Gerace in view of Tuzhilin (US006236978B1). Gerace does not teach that the user profile defines one or more advertisers or favorite products. Tuzhilin teaches (col. 11 lines 21-23) that the user profile defines one or more favorite brands, which reads on advertisers or favorite products. Because Tuzhilin teaches the construction of dynamic profiles for large groups of users (col. 1 line 52 to col. 2 line 20), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Tuzhilin to those of Gerace.

(10) Response to Argument

A. Grounds of Rejection No. 1: Whether claims 1-3, 6-10, 12-23 and 27-30 are properly rejected under 35 U.S.C. 102(b) as being anticipated by Gerace.

The appellant does not address the rejection. The appellant's argument amounts to a general allegation that the claims are patentable without distinctly and specifically pointing out the supposed errors in the examiner's action. The instant argument does not meet the requirements of 37 CFR § 1.111(b): The instant argument would not have been acceptable as a reply to an Office action. The rule is apparently not a requirement for an appeal, but the Board should ask why the appellant has seen fit to not address the rejection.

In lieu of addressing the rejection, the appellant picks selectively from Gerace to allegedly demonstrate that Gerace does not teach the claim limitations. The examiner never said that every embodiment in Gerace reads on the claims. As was noted in the rejection (para. 2 above), "A reference is available as prior art for all that it teaches (MPEP § 2123.I.)."

In the following, everywhere where the appellant alleges that Gerace does not teach a claimed limitation, the examiner will cite where Gerace does teach the subject limitation. The appellant also argues that Gerace does not teach limitations which have not in fact been claimed. Some of these cases are noted below.

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The appellant alleges,

"Gerace does not provide advertisements based on preferences knowingly provided by the user." (brief p. 10, middle para.), and

"Thus, the Gerace patent fails to create user profiles based on information inputted by a user . . ." (Brief p. 10, beginning of the bottom para.)

First, there is no literal claim limitation to providing "advertisements based on preferences knowingly provided by the user". In fact, Gerace teaches providing advertisements based on preferences as follows:

"determining matching ad profiles by comparing the ad profiles with user profiles for matches (col. 2 lines 31-34 and col. 35 lines 64-67), and

selectively including in the interface (page) of a user at least one of the one or more ads associated with the ad profiles matching a user profile associated with the user (col. 2 lines 24-29)." (Para. 6 of the rejection, emphasis added.)

As to the second allegation, In fact, Gerace teaches creating user profiles based on information inputted by a user:

"displaying an online page (*Home Page*, col. 4 lines 1-4) to one or more users seeking information (*user identification information*, col. 5 lines 5-7, and *user provides certain data*, col. 11 line 32) from the one or more users and allowing the one or more users to knowingly enter their information (*nickname, password, e-mail address, postal address, credit card number, and the like*, col. 6 lines 2-5 and col. 13 lines 62-63, and *zip code*, col. 16 lines 30-36) for creating their respective one or more user profiles (col. 5 line 63 to col. 6 line 1 and the personalized *Weather Page/Screen View*, col. 16 lines 30-36, and the customized content and screen formats, col. 11 lines 24-35);² (Para. 6 of the rejection, emphasis added.)

The appellant alleges, "Gerace does not provide a page to the end user . . ." (Brief p. 11, end of third para. from the bottom.) In fact, Gerace teaches (as was noted above and in

² In addition, Gerace teaches (col. 17 line 53 to col. 18 line 9) displaying an online page to one or more users (*sponsor-users*) seeking information from the one or more user/*sponsor-users* and allowing the one or more user/*sponsor-users* to knowingly enter their information for creating their respective one or more user profiles (the *advertisers template*).

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rejection para. 6, emphasis added here), “displaying an online page (*Home Page*, col. 4 lines 1-4)”.

The appellant alleges, “As to claims 13 and 14, there is absolutely no teaching in Gerace for having a user define the amount or percentage of space for the ads.” (Brief p. 11, second para. from the bottom.) In fact, Gerace teaches,

“Gerace also teaches claim 15, because the *Page Display Object 35c* defines page outlines (col. 7 lines 39-40), which read on a page “framework”, and the user adds said outline/framework to the user profile by selecting such a page for viewing (col. 7 lines 53-57). Accordingly, **Gerace also teaches claims 13 and 14 because these outlines (Appendix I beginning in col. 23) fully define page outlines including spaces.** (Para. 10 of the rejection, emphasis added.)

B. Grounds of Rejection No. 2: Whether claims 11 and 24-26 are properly rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace.

The appellant alleges,

“There is absolutely no basis for significantly modifying an invention working off “cookies” to create Applicant’s claimed invention, which is not cookies based, but based on information knowingly entered by the user to create his or her customized page.” (Brief p. 12, beginning of the last para.)

The appellant’s comment is irrelevant. The rejection deals with charging the advertiser based on the amount of ad space available (para. 11 and 12 of the rejection). What “cookies” have to do with this is not made clear by the appellant.

C. Grounds of Rejection No. 3: Whether Claims 4 and 5 are properly rejected under 35 U.S.C. 103(a) as being obvious over Gerace in view of Tuzhilin.

Appellant argues,

“The Examiner has stated that Tuzhilin teaches that the user profile defines one or more favorite brands, which reads on advertisers or favorite products. Even if this interpretation is correct, Tuzhilin fails to overcome the fundamentally differences of how the user profile is created in Gerace as compared to Applicant’s invention.

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Accordingly, the proposed combination of Gerace and Tuzhilin still fails to teach applicant's unique invention, as now claimed." (Brief p. 13, second full para. from the bottom.)

The examiner has shown precisely where every claim limitation is taught by or obvious over the cited prior art. The appellant alleges "fundamental differences" between the claimed and reference inventions, but the appellant has not shown where the examiner's rejection is wrong. The only reasonable conclusion is that the alleged differences do not exist.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Donald L. Champagne
Primary Examiner
Art Unit 3622

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

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